

### **REMARKS**

In the Office Action that was mailed on May 19, 2004, claims 5-6 and 12-13 were rejected under 35 U.S.C. § 112, second paragraph, for indefiniteness; claims 1-6 and 14-16 were rejected under 35 U.S.C. § 102(b) as being anticipated by Hall et al. (U.S. Patent No. 5,974,541) ("Hall"); and claims 7-13 and 17-18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hall. The foregoing rejections are respectfully traversed.

Claims 1-18 are pending in the subject application, of which claims 1, 7, 14, and 17 are independent claims.

#### **Amendments to the Claims:**

Claims 1, 7, 10, 14, and 17 are amended herein to recite "removable storage device," and new dependent claims 19-34 are added herein. Care has been exercised to avoid the introduction of new matter.

Support for the amendments to claims 1, 7, 10, 14, and 17 may be found in the Specification at page 11, lines 10-19. Support for new dependent claims 19-20 may be found in the Specification at page 18, lines 2-4. Support for new dependent claims 21 and 24 may be found in the Specification at page 12, lines 16-21. Support for new dependent claim 22 may be found in the Specification at page 14, lines 6-7. Support for new dependent claims 23 and 25 may be found in the Specification at page 13, lines 2-3. Support for new dependent claims 26-29 may be found in the Specification at page 13, lines 10-19. Support for new dependent claims 30-32 may be found in the Specification at page 17, lines 15-19. Support for new dependent claims 33-34 may be found in the Specification at page 11, lines 18-19 and at page 15, lines 21-22.

#### **Rejections of the Claims:**

##### **Rejections Under 35 U.S.C. § 112, second paragraph:**

In item 3, on page 2 of the Office Action, the examiner rejected claims 5-6 and 12-13 under 35 U.S.C. § 112, second paragraph, for lack of antecedent basis as being "inappropriate dependents." Specifically, the examiner stated that claims 5 and 12 recite computer-readable medium claims that depend from method claims 1 and 7, respectively, and that claims 6 and 13 recite computer system claims that depend from method claims 1 and 7, respectively.

MPEP § 2173.05(f) permits dependent claims of one type to depend from a claims of a different type. For example, the MPEP states that “claims which read: ‘The product produced by the method of claim 1.’ ... are not indefinite under 35 U.S.C. § 112, second paragraph ... .” MPEP § 2173.05(f). In addition, many patents have issued with dependent claims in a format similar to that of claims 5 and 12. For example, claim 21 of U.S. Patent No. 5,781,707 recites the following language: “21. A computer-readable medium having computer-executable instructions for performing the method as recited in claim 1.”

Therefore, claims 5-6 and 12-13 are not indefinite under section 112, second paragraph, and the Applicants respectfully request that the examiner withdraw the rejections thereof.

#### **Rejections Under 35 U.S.C. § 102(b):**

In item 4, on pages 3-4 of the Office Action, the examiner rejected claims 1-6 and 14-16 under 35 U.S.C. § 102(b) as being anticipated by Hall. The examiner cited the GPIB device of Hall as the device recited in the subject application. (Office Action, p. 3). Hall refers to the IEEE 488 standard in discussing GPIB (Hall, col. 1, lines 13-14), which is a standard that is well known in the art. GPIB is a standard parallel interface that is used for attaching sensors and programmable instruments to a computer. In Hall, the term “GPIB instrument” is synonymous with the term “GPIB device.” (Hall, col. 1, lines 13-33). The examiner recognized this relationship on page 5 of the Office Action, where he asserted that the device in claim 7 was anticipated by the GPIB instrument of Hall. In addition, Hall discusses that GPIB instruments are used “to analyze, measure or control a unit under test (UUT) or process 130.” (Hall, col. 3, lines 47-49). Consequently, the GPIB instruments/devices in Hall are used for measurement and analysis, not for storage.

In contrast, independent claims 1 and 14 of the subject application (as amended herein) recite a “removable storage device.” Therefore, the GPIB device in Hall does not anticipate the removable storage device that is recited in independent claims 1 and 14 because the GPIB device is not a removable storage device.

Accordingly, independent claims 1 and 14 of the subject application (as amended herein) are patentably distinguishable over the cited reference. In addition, dependent claims 2-6 and 15-16 of the subject application are allowable based in part on their dependency, directly or indirectly, from one of claims 1 and 14. The Applicants respectfully request that the examiner withdraw the rejections of claims 1-6 and 14-16.

**Rejections Under 35 U.S.C. § 103(a):**

In item 5, on pages 5-6 of the Office Action, the examiner rejected claims 7-13 and 17-18 under 35 U.S.C. § 103(a) as being unpatentable over Hall. Independent claims 7 and 17 (as amended herein) recite a "removable storage device," and are therefore patentably distinguishable for the same reasons as discussed above in regard to the rejections under § 102(b). In addition, dependent claims 8-13 and 18 of the subject application are allowable based in part on their dependency, directly or indirectly, from one of independent claims 7 and 17. The Applicants respectfully request that the examiner withdraw the rejections of claims 7-13 and 17-18.

**Lack of Motivation to Modify Hall:**

In addition, MPEP § 706.02(j) requires that, to establish a *prima facie* case of obviousness under § 103, "there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. ... The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure."

MPEP § 2142 states that "[w]hen the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the examiner to explain why the combination of the teachings is proper." The examiner is required to present actual evidence and make particular findings related to the motivation to combine the teachings of the references. In re Kotzab, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000); In re Dembiczak, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Broad conclusory statements regarding the teaching of multiple references, standing alone, are not "evidence." Dembiczak, 50 USPQ2d at 1617. "The factual inquiry whether to combine the references must be thorough and searching." In re Lee, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002) (citing McGinley v. Franklin Sports, Inc., 60 USPQ2d 1001, 1008 (Fed. Cir. 2001)). The factual inquiry must be based on objective evidence of record, and cannot be based on subjective belief and unknown authority. Id. at 1433-34. The examiner must explain the reasons that one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious. In re Rouffet, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998).

The examiner has not presented any evidence why someone of ordinary skill in the art would have modified Hall. The mere fact that reference can be modified does not render the resultant modification obvious unless the prior art also suggests the desirability of the modification. MPEP § 2143.01. Specifically, there must be a suggestion or motivation in the references to make the modification. Id. The examiner's sole support for such a modification is that "one of ordinary skill in the art would conclude that the application control the functions of the device by sending commands or tasks to the device, such commands or tasks create [sic] event within the device ... ." (Office Action, p. 5) (errors in original). The examiner cannot rely on the modification without first supporting the motivation to make the modification. Such motivation does not appear anywhere in the reference, and the examiner has not presented any actual evidence in support of the same. Instead, the examiner relies on broad conclusory statements, subjective belief, and unknown authority. Such a basis does not adequately support the modification of Hall; therefore, the modification is improper and must be withdrawn.

**Rejection of Claim 10:**

The examiner rejected dependent claim 10 "for the same reasons as claims 4 and 7 above." (Office Action, p. 5). However, dependent claim 10 does not recite the same feature as dependent claim 4. Specifically, claim 4 recites that "the change notifications include a globally unique identifier", and claim 10 recites that "the initiated task alters the identification of the device." Clearly, claim 10 should not be rejected for the same reasons as claim 4, because the two claims recite different features. The Applicants respectfully request that the examiner withdraw the rejection thereto.

As a result, the Applicants have not yet been provided with the examiner's reasons for rejecting dependent claim 10. MPEP § 706.07 prevents the examiner from making an immediately subsequent Office Action a final action, because a clear issue in regard to dependent claim 10 has not been developed.

Withdrawal of the foregoing rejections is respectfully requested.

There being no further objections or rejections, it is submitted that the application is in condition for allowance, which action is courteously requested. Finally, if there are any formal matters remaining after this response, the examiner is requested to telephone the undersigned to attend to these matters. If there are any additional fees associated with filing of this

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Amendment dated 08/19/04  
Reply to Office Action of May 19, 2004

Amendment, please charge the same to our Deposit Account No. 19-2112.

Respectfully submitted,



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